

C fused with 20 amino acids of pre-S1 region of HBV polypeptide. Claims 1 to 4, 10, and 15 read on the elected construct.

The restriction requirement is improper because the Examiner has not shown that examining the entire subject matter of the claims would constitute a serious burden. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus for a restriction requirement to be valid, the Examiner must establish the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden (M.P.E.P. § 803).

First, the subject matter of the claimed invention has already been searched by the European Patent Office. A copy of the European Search Report was included with the Information Disclosure Statement filed on March 17, 2000.

Second, as to Groups II and III, these groups contain claims drawn to polynucleotides, vectors, and host cells that encode or produce the subject matter of the claims of Group I and these claims are dependent on the claims of Group I. A search of the subject matter of Group I would necessarily include the subject matter of Groups II and III.

Third, as to Groups IV and VI, these groups contain claims drawn to methods for treating or preventing HBV infection using the subject matter of the claims of Group I and these claims are dependent on the claims of Group I. A search of the subject matter of Group I would necessarily include the subject matter of Groups IV and VI.

Fourth, as to Group V, this group contains claims drawn to antibodies, methods for producing antibodies, and methods for treating HBV infection using antibodies that are dependent on the claims of Group I. While these claims are a

small step removed from the other claims due to the use of antibodies instead of polypeptides, a search of the subject matter of Group I still would necessarily include the subject matter of Group V.

In view of the above remarks, Applicant respectfully requests reconsideration and withdrawal or modification of the restriction requirement.

The election requirement is improper because there is no provision in the M.P.E.P. for an election of species requirement that purports not to be one. To the extent that Applicant understands the election requirement on pages two to four of the August 1, 2001 Office Action, the Examiner seems to be taking the position that only one polypeptide will be searched and even if that polypeptide is found to be patentable the Examiner will not search the full subject matter of the elected claims.

In the usual procedure, a species is elected for examination and if the Examiner finds that the species is allowable, the search must be expanded. Under Applicant's current understanding of the election requirement, if the Examiner finds that the elected polypeptide is patentable but refuses to search the rest of the claim, the claim cannot be rejected and it should not be allowed because the entire subject matter of the claim has not been searched. The Examiner would have to draft extremely narrow claims and impose them on the Applicant. There is no provision in the statute, rules, or M.P.E.P. for such a procedure.

In view of the above remarks, Applicant respectfully requests reconsideration and withdrawal or modification of the election requirement.

Response

Attorney Docket: KCO1002US

Applicant: Steven Neville Chatfield

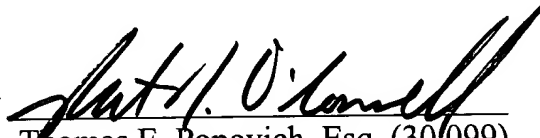
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Respectfully submitted,

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